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10/816,575	04/01/2004	Gregory E. Borchers	SCK7146.0176	1234
52894	7590	06/21/2007	EXAMINER	
KRIEGER INTELLECTUAL PROPERTY, INC. P.O. BOX 1073 CAMSAS, WA 98607			WANG, JUE S	
		ART UNIT	PAPER NUMBER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/816,575	BORCHERS, GREGORY E.
	<b>Examiner</b>	<b>Art Unit</b>
	Jue S. Wang	2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 07 April 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-16 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 07 April 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
 Paper No(s)/Mail Date 07 April 2004.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Claims 1-16 have been examined.

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities:

Claim 6 is missing the punctuation mark ‘.’ at the end of the claim.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The following lacks antecedent basis in the claims:

- i. Claim 4, “said device” in line 8.
- ii. Claim 5, “said direct link” in line 1.
- iii. Claim 7, “said device” in line 10.
- iv. Claim 13, “said method” in line 1.

B. The following claim language is not clear and indefinite:

- i. As per claim 1, the term “said device” is used in line 5. While it is obvious that the device refers to the firmware device in line 3, applicants are required to be consistent in claim language and use the same term.

- ii. As per claim 1, line 6, and claim 4, line 8, the term “restoring” is used in. This limitation is not clearly understood (i.e., is the configuration data merely stored in the new firmware structure, or is the configuration data converted to a format that is compatible with the new firmware structure and then stored, or is the configuration data merged with existing configuration data already contained in the new firmware structure?)
- iii. As per claim 6, lines 1-2, the term “additional configuration data” is used. This limitation is not clearly understood (i.e., is the additional configuration data the original configuration data that is extract, or is the additional configuration data from the “new” firmware structure?)
- iv. As per claim 12, lines 1-2, the phrase “wherein said downloading and installing are accomplished in a single step” is used. This limitation is not clearly understood since downloading and installing are two separate operations and thus should require two steps to perform.
- v. As per claim 15, line 2, the phrase “additional configuration information” is used. This limitation is not clearly understood (i.e., is the additional configuration information used to convert the original configuration data into a new format compatible with new firmware structure, or is the additional information new configuration settings for the new firmware structure not currently available in the original configuration data?)

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Guess (US 2003/0204711 A1).

7. As per claim 1, Guess teaches the claimed invention including a method for preserving configuration data during firmware modification (see abstract, lines 13-16, and [0013]), said method comprising:

- a) extracting configuration data from an existing firmware structure in a firmware device (see Fig 3, Fig 4-2, step 270, abstract, [0060], and [0068]);
- b) storing said configuration data (see Fig 3, Fig 4-2, steps 280, 290, abstract, lines 13-16, [0060], and [0069]);
- c) downloading a new firmware structure to said device (see Fig 4-2, step 310, abstract, [0063], and [0070]); and
- d) restoring said configuration data to said new firmware structure in said firmware device (see Fig 3, Fig 4-2, steps 320, 330, abstract, [0064], [0065], and [0072]).

8. As per claim 3, Guess teaches the downloading is accomplished via a link between a downloading computing device and said firmware device (see [0023], [0027], and [0055]).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 2 and 4-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Guess (US 2003/0204711 A1), in view of Woodard et al. (US 2002/0104080 A1, hereinafter Woodard).

11. As per claim 2, Guess does not teach said storing takes place on a web server. Woodard teaches storing application settings within a remote server system (see Fig 1, Fig 3, [0011], and [0012]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Guess such that the configuration data is stored in a web server as taught by Woodard because the stored application settings can be retrieved by the subscriber for purposes of restoring a crashed system (see [0012] of Woodard).

12. As per claim 4, Guess teaches the invention as claimed including a method for preserving configuration data during firmware modification (see abstract and [0013], said method comprising:

- a) extracting configuration data from an existing firmware structure in a firmware device (see Fig 3, Fig 4-2, step 270, abstract, [0060], and [0068]);
- b) storing said configuration data (see Fig 3, Fig 4-2, steps 280, 290, abstract, [0060], and [0069]);
- c) downloading a new firmware structure from a download computing device to said firmware device, wherein said downloading is accomplished via a direct connection (see Fig 4-2, step 310, abstract, [0063], and [0070]); and
- d) restoring said configuration data to said new firmware structure in said device (see Fig 3, Fig 4-2, steps 320, 330, abstract, [0064], [0065], and [0072]).

Guess does not teach said extracting is accomplished over a network connection and storing said configuration data on a web server.

Woodard teaches extracting application settings from a computing device over a network connection and storing the extracted application settings within a remote server system (see Fig 1, Fig 3, Fig 5, [0010] - [0012]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Guess such that the configuration data is extracted over a network connection and stored in a web server as taught by Woodard because the server system provides a network-based, easy, fast, and comprehensive method of extraction/transference of settings and stored

application settings can be retrieved by the subscriber for purposes of restoring a crashed system (see [0008] and [0012] of Woodard).

13. As per claim 5, Guess further teaches said direct connection is a serial connection (see [0023], [0027], and [0055]).

14. As per claim 6, Guess further teaches said restoring also comprises installing additional configuration data (see Fig 3, Fig 4-2, steps 320, 330, abstract, [0064], [0065], and [0072]).

15. As per claim 7, Guess teaches the invention as claimed including a method for preserving configuration data during firmware modification (see abstract and [0013]), said method comprising:

- a) extracting configuration data from an existing firmware structure in a firmware device (see Fig 3, Fig 4-2, step 270, abstract, [0060], and [0068]);
- b) storing said configuration data (see Fig 3, Fig 4-2, steps 280, 290, abstract, [0060], and [0069]);
- c) downloading a new firmware structure from a download computing device to said firmware device thereby replacing said existing firmware structure (see Fig 4-2, step 310, abstract, [0063], and [0070]);
- d) converting said configuration data to a format compatible with said new firmware structure (see Fig 3, Fig 4-2, step 320, [0056], and [0072]) and

e) installing said converted configuration data to said new firmware structure in said device (see Fig 3, Fig 4-2, step 330, abstract, and [0055]-[0057]).

Guess does not teach that the extracted configuration data is uploaded over a network connection.

Woodard teaches that uploading extracted application settings over a network connection (see Fig 1, Fig 3, Fig 5, and [0051] of Woodard).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Guess such that the extracted configuration data is uploaded over a network connection as taught by Woodard because the server system provides a network-based, easy, fast, and comprehensive method of extraction/transference of settings and stored application settings can be retrieved by the subscriber for purposes of restoring a crashed system (see [0008] and [0012] of Woodard).

16. As per claim 8, Guess does not teach said storing is accomplished on a web server.

Woodard teaches said storing is accomplished on a web server (see [0012]).

17. As per claim 9, Guess further teaches said storing is accomplished on a downloading computing device (see [0046], [0061]-[0062]).

18. As per claim 10, Guess further teaches said storing is accomplished on said firmware device (see [0054] and [0069]).

19. As per claim 11, Guess further teaches said downloading is accomplished over a serial link (see [0023], [0027], and [0055]).

20. As per claim 12, Guess further teaches said downloading and said installing are accomplished in a single step (see [0027], [0053]-[0058], [0066], and [0079]; EN: the download and the installing are considered to be accomplished in a single step since the configuration settings are installed into the newly downloaded firmware automatically via the “setting preservation software” rather than via a service technician).

21. As per claim 13, Guess teaches the invention as claimed including a system for preserving configuration data during firmware modification (see [0074]), said system comprising:

a) a firmware device comprising an upgradable firmware structure and configuration data (see abstract, [0013], [0029]-[0031], and [0075]);  
c) a download computing device (see [0022], [0027], [0055], and [0078]); and  
e) a direct connection between said firmware device and said download computing device, wherein configuration data is extracted from said firmware device and stored while said firmware structure is upgraded to a new firmware structure and wherein said configuration data may be installed to said new firmware structure after upgrading thereby preserving said configuration data (see Fig 3, Fig 4, abstract, [0060], [0063]-[0065], [0068]-[0072]).

Guess does not teach a web-based data management utility residing on a server, a network connection connecting said firmware device, said download computing device, and said

web-based management utility, and said management utility may recover said configuration data from said firmware device and store said configuration data on said server.

Woodard teaches a web-based data management utility residing on a server (see Fig 3, abstract, [0038], [0049], [0050]), a network connection connecting a computing device, a download computing device, and said web-based management utility (see abstract, [0009]-[0013]), and said management utility may recover application settings from a computing device and store said application settings on said server (see Fig 5, abstract, and [0051]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the system of Guess to contain a web-based data management utility residing on a server, a network connection connecting said firmware device, said download computing device, and said web-based management utility, and said management utility may recover said configuration data from said firmware device and store said configuration data on said server as taught by Woodard because the server system provides a network-based, easy, fast, and comprehensive method of extraction/transference of settings and stored application settings can be retrieved by the subscriber for purposes of restoring a crashed system, transference to a repaired or new system, converted for use on a new differing device or updated to reflect changes in software (see [0008] and [0012] of Woodard).

22. As per claim 14, Guess further teaches said configuration data is converted to a new format before installation on said firmware structure (see Fig 3, Fig 4-2, step 320, [0055]-[0057], and [0072]).

23. As per claim 15, Guess further teaches said configuration data is compiled with additional configuration information before installation on said new firmware structure (see Fig 3, Fig 4-2, step 320, [0055]-[0057], and [0072]).

24. As per claim 16, Guess does not teach said additional configuration information is obtained by querying network devices.

Woodard teaches obtaining additional configuration information by querying network devices (see [0052] and [0053]).

### *Conclusion*

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Ott (US 6,671,802 B1) is cited to teach performance optimization of computer system by dynamically and immediately updating a configuration setting based on detected change in preferred use.
- Kay et al. (US 6,096,094) is cited to teach a configuration manager for configuring a data acquisition system.
- Autry (US 6,990,577 B2) is cited to teach updating a BIOS image by replacing portion of the BIOS image with a portion of another BIOS image.
- Yuh et al. (US 7,093,003 B2) is cited to teach a system and method for upgrading the remote control functionality of a device.

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- Nguyen et al. (US 7,117,482 B2) is cited to teach migration of configuration data from one software installation through an upgrade.
- Broeksteeg et al. (US 2002/0124243 A1) is cited to teach a method and program for updating software.
- Grieve et al. (US 2003/0149756 A1) is cited to teach a configuration management method and system.
- Heisey et al. (US 2004/0015940 A1) is cited to teach an intelligent device upgrade engine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jue S. Wang whose telephone number is (571) 270-1655. The examiner can normally be reached on M-Th 7:30 am - 5:00pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on 571-272-3756. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J.W.  
6/5/2007



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